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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,936	04/11/2001	Emmanuel Conseiller	ST98033	7710

29693 7590 11/14/2002
WILEY, REIN & FIELDING, LLP
ATTN: PATENT ADMINISTRATION
1776 K. STREET N.W.
WASHINGTON, DC 20006

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/14/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/829,936

Applicant(s)

CONSEILLER ET AL.

Examiner

Sheela J Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-97 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 31-97 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 31-32, drawn to polypeptide containing all or part of SEQ ID No. 9, classified in class 530, subclass 350+.
- II. Claims 31-32, drawn to polypeptide containing all or part of SEQ ID No. 16, classified in class 530, subclass 350+.
- III. Claims 31 and 33, drawn to polypeptide containing all or part of SEQ ID No. 31, classified in class 530, subclass 350+.
- IV. Claims 31 and 33, drawn to polypeptide containing all or part of SEQ ID No. 22, classified in class 530, subclass 350+.
- V. Claims 31 and 34, drawn to polypeptide containing all or part of SEQ ID No. 33, classified in class 530, subclass 350+.
- VI. Claims 36-37, 41, 43, 44, 47, 48, 52-53, 57, 59, 62-63, 67-68, 77 and 81, drawn to nucleic acid SEQ ID No. 15, vectors and host cells containing said sequence, classified in class 536, subclass 23.1+.
- VII. Claims 36, 41, 45-47, 52, 57, 62, 67 and 81 drawn to nucleic acid SEQ ID No. 21, vectors and host cells containing said sequence, classified in class 536, subclass 23.1+.
- VIII. Claims 36, 42, 47, 52, 57, 62, 67, and 81 drawn to nucleic acid SEQ ID No. 32, vectors and host cells containing said sequence, classified in class 536, subclass 23.1+.

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- IX. Claims 36, 37, 43-44, 47, 48, 52-53, 57, 59, 62, 63, 67-68, 77 and 81 drawn to nucleic acid SEQ ID No. 30, vectors and host cells containing said sequence, classified in class 536, subclass 23.1+.
- X. Claims 38, 49, 54, 64 and 69 and 78 drawn to nucleic acid encoding a polypeptide of SEQ ID No. 31, classified in class 536, subclass 23.1.
- XI. Claims 38, 40 49, 51, 54, 56, 61, 64, 66, 69, 71, 78, 80 drawn to nucleic acid encoding a polypeptide of SEQ ID No. 22, classified in class 536, subclass 23.1.
- XII. Claims 39, 50, 55, 60, 65, 70 and 79 drawn to nucleic acid encoding a polypeptide of SEQ ID No. 33, classified in class 536, subclass 23.1.
- XIII. Claims 72, 74-76 and 96 drawn to the antisense to SEQ ID No. 15, classified in class 514, subclass 44.
- XIV. Claims 72, 76 and 96 drawn to the antisense to SEQ ID No. 21, classified in class 514, subclass 44.
- XV. Claims 73, 76, and 96 drawn to the antisense to SEQ ID No. 32, classified in class 514, subclass 44.
- XVI. Claims 74-76 and 96 drawn to the antisense to SEQ ID No. 30, classified in class 514, subclass 44.
- XVII. Claims 82-83 and 97 drawn to antibody directed against polypeptide SEQ ID NO. 9, classified in class 530, subclass 387.1+.
- XVIII. Claims 82-83 and 97 drawn to antibody directed against polypeptide SEQ ID NO. 16, classified in class 530, subclass 387.1+.

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- XIX. Claims 82-83 and 97 drawn to antibody directed against polypeptide SEQ ID NO. 22, classified in class 530, subclass 387.1+.
- XX. Claims 82-83 and 97 drawn to antibody directed against polypeptide SEQ ID NO. 31, classified in class 530, subclass 387.1+.
- XXI. Claims 82-83 and 97 drawn to antibody directed against polypeptide SEQ ID NO. 33, classified in class 530, subclass 387.1+.
- XXII. Claims 84-87 and 95 drawn methods of detecting a compound using the polypeptide SEQ ID NO. 9, classified in class 435, subclass 7.1+.
- XXIII. Claims 84-87 and 95 drawn methods of detecting a compound using the polypeptide SEQ ID NO. 16, classified in class 435, subclass 7.1+.
- XIV. Claims 84-87 and 95 drawn methods of detecting a compound using the polypeptide SEQ ID NO. 22, classified in class 435, subclass 7.1+.
- XV. Claims 84-87 and 95 drawn methods of detecting a compound using the polypeptide SEQ ID NO. 31, classified in class 435, subclass 7.1+.
- XVI. Claims 84-87 and 95 drawn methods of detecting a compound using the polypeptide SEQ ID NO. 33, classified in class 435, subclass 7.1+.
- XVII. Claims 88-94 drawn to a compound detected by using SEQ ID no. 9 and compositions containing said sequence and methods of using said compound, classified in 514, subclass 12+.
- XVIII. Claims 88-94 drawn to a compound detected by using SEQ ID no. 16 and compositions containing said sequence and methods of using said compound, classified in 514, subclass 12+.

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XIX. Claims 88-94 drawn to a compound detected by using SEQ ID no. 22 and compositions containing said sequence and methods of using said compound, classified in 514, subclass 12+.

XXX. Claims 88-94 drawn to a compound detected by using SEQ ID no. 31 and compositions containing said sequence and methods of using said compound, classified in 514, subclass 12+.

XXXI. Claims 88-94 drawn to a compound detected by using SEQ ID no. 33 and compositions containing said sequence and methods of using said compound, classified in 514, subclass 12+.

The inventions are distinct, each from the other because of the following reasons:

Inventions [I-V], [VI-XII], [XIII-XVI] and XVII-XXI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions because they are directed to structurally and chemically different products and the products all have different uses. For example, the polynucleotides can be used in hybridization assays, whereas the products of the other groups cannot. The polypeptides can be used to make antibodies and in therapy, whereas the compounds of the other groups cannot. The antibodies can be used in immunoassays, affinity purification etc, whereas the compounds of the other groups cannot.

The methods of groups XXII-XVI and XVII-XXXI are different because each group uses a different compound and has different steps and end results.

Each group is directed to a single sequence because each sequence is patentably distinct. If applicant disagrees then applicant is requested to show each sequence is related to the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Due to the complexity of this restriction, a telephone call was not made to request an oral election to the above restriction requirement.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on M,Th 5:30 am-2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Sheela J Huff
Primary Examiner
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sjh

November 14, 2002